



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,200	12/18/2000	Adrian J McHugh	673-1020	4325

23644 7590 06/15/2005

BARNES & THORNBURG  
P.O. BOX 2786  
CHICAGO, IL 60690-2786

EXAMINER

SALAD, ABDULLAHI ELMI

ART UNIT PAPER NUMBER

2157

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/740,200

Applicant(s)

MCHUGH ET AL.

Examiner

Salad E. Abdullahi

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 15, 16, 18, 30-32, 36, 38 and 40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15, 16, 18, 30-32, 36, 38 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**Response to amendment**

1. The amendment filed on 3/25/2005 has been received and made of record.
2. Applicant's arguments with respect to claims 1-11, 15-16, 18, 30-32, 36, 38 and 40 have been fully considered but not persuasive for the following reasons.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 recites the limitation "said data request" in line 7. There is insufficient antecedent basis for this limitation in the claim.

***Claim Objections***

5. Claim 38 is objected to because of the following informalities: claim 38 depends on a cancelled claim 37. Appropriate correction is required.

***Response to Arguments***

6. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., client device (third device) instructs the content server (second device to request its data directly from the form filling server (first device0)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-19, 25-32, and 35-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Markus U. S. Patent No. 6,499,042[hereinafter Markus].

As per claim 1, Markus discloses a method of transferring data relating to a user from a first data processing device (15) to a second data processing device (14) over a communications network, said method comprising the steps of:

- (a) said user being connected to said network by a third data processing device which physically remote from said first device (see fig. 2 and col. 2, line 65 to col.3, line 10).
- (b) said third device to accessing a web page hosted by said second device (see fig. 2 and col. 2, line 65 to col.3, line 10).
- (c) said first device (form-filling server or selective proxy) directing said second device to forward a data request to said first device in order to supply information requested on said web page (see fig. 3, col. 1, lines 41-46 and col. 3, lines 20-64);

Art Unit: 2157

- (d) said first device (form-filling server or selective proxy) receiving over said network from said second device (form-originating server) a request for said data, said request including an identification of one or more pre-defined data elements for which the request is made (see fig. 3, col. 1, lines 41-46 and col. 3, lines 20-64);
- (d) said first device accessing a file containing data relating to the user, said file including data elements identified by data element identifiers and retrieving from said file one or more of said data elements identified in said request (see fig. 3, col. 1, lines 41-46 and col. 3, lines 20-64); and
- c) said first device forwarding to said second device said retrieved data elements (see col. 3, lines 43-47).

As per claim 2, Markus discloses a method according to claim 1 wherein one or both of said first and second devices are computers (see fig. 3).

As per claim 3, Markus discloses a method according to claim 1, wherein said file is stored on said first device (see col. 3, lines 37-52).

As per claim 4, Markus discloses a method according to claim 1, wherein said request is in the form of a web page having one or more fields for receiving data elements, and wherein said identification of one or more pre-defined data elements is in the form of a machine-readable tag accompanying said one or more fields (see col. 3, lines 20-64).

Art Unit: 2157

As per claim 5, Markus discloses the a method according to claim 4, wherein said first device retrieves from said data file those data elements having identifiers which correspond to the tags in the request (see col. 3, lines 20-64).

As per claim 6, Markus discloses a method according to claim 5, wherein a browser engine (document browser) operating on said first device adds said retrieved data elements to said web page and presents the web page including the added data elements to a user before forwarding said data elements to said second device (see col. 3, lines 20-24).

As per claim 7, Markus discloses a method according to claim 6, wherein said browser engine provides the user with the option to confirm the submission of said data elements before forwarding said data elements to said second device (see col. 2, lines 13-17).

As per claim 8, Markus discloses a method according to claim 6, wherein said browser engine provides the user with the option to vary said data elements before forwarding said data elements to said second device (see col. 2, lines 13-17).

As per claim 9, Markus discloses a method according to claim 1, further comprising the step of said first device logging the submission of said data elements to said

second device (see col. 3, lines 49-52).

As per claim 10, Markus discloses a method according to claim 1, wherein said first device is a server (proxy server) which stores said data on behalf of said user (see col. 1, lines 31-40).

As per claim 11, Markus discloses a method according to claim 10, further comprising the step of verifying with said user that the data should be forwarded to said second device (see col. 2, lines 13-17).

As per claim 15, Markus discloses the method according to claim 1, wherein said user provides said second device with the network address of said first device (see col. 1, lines 18-31).

As per claim 16, Markus discloses a method according to claim 1, wherein said first device generates a verification request to said user in response to the data request being received from said second device (see col. 3, lines 31-39).

As per claim 18, Markus discloses a method according to claim 17, wherein said verification request is passed from said first device to said third device via the second device (see fig. 3, steps 21-23 and col. 3, lines 31-37).

Art Unit: 2157

As per claim 30, Markus discloses a computer program product (computer instruction) in machine readable form containing instructions which when executed cause a computing device ("the second device") to:

- a) receive from a remote computing device ("the third device") an instruction identifying the network address of a further remote computing device ("the first device")(see fig. 3, col. 1, lines 41-46 and col. 3, lines 20-64);
- b) issue a request for data to said first device, wherein said request includes an identification of one or more pre-defined data elements for which the request is made (see col. 1, lines 41-46 and col. 3, lines 20-64);and
- c) receive from said first device one or more of said identified data items (see col. 3, lines 20-64).

As per claim 31, Markus discloses a computer program product according to claim 30, further effective to cause said second device to forward said data items received from said first device to said third device, and await confirmation that said data items are valid(see col. 3, lines 43-49, where the external entity 13, verifies and corrects the received content and sends the result selective proxy device).

As per claim 32, Markus discloses a computer program product in machine readable form containing instructions which when executed cause a computing device to:

- a) receive as an input a network address of a remote computing device (see fig. 3, col. 1, lines 41-46 and col. 3, lines 20-64);



Art Unit: 2157

- b) forward to said network address a request for data relating to an identified user;
- c) receive from said remote computing device data relating to the user (col. 3, lines 20-64); and
- d) utilize said data in a transaction with the user (see col. 3, lines 20-64).

As per claim 36, Markus discloses an information transfer system comprising:

- a) a communications network (see fig. 2);
- b) first and second data processing devices(14 and 15) connected to said network (see fig. 2);
- c) a storage unit (disk farm) associated with the first device (selective proxy) and containing a plurality of data items relating to a user, in which said data items are organized by data item identifiers (see col. 1, lines 41-58);
- d) computer program means associated with the first device which when executed cause the first device to:
  - i) determine from a request received from said second device an identification of one or more data items for which the request has been made (see col. 3, lines 20-64);
  - ii) retrieve available data items from said storage unit (see col. 3, lines 20-64);and
  - iii) transmit said data items to said second unit(see col. 3, lines 20-64);
- (e) a third processing device connecting said user to said network(see fig. 2 and col. 2, line 65 to col.3, line 10).
- (f) a computer program means associated with said second device which when executed causes said second device to receive instruction from said third device

Art Unit: 2157

identifying the network address of the first device (see fig. 3, col. 1, lines 41-46 and col. 3, lines 20-64); and  
transmit said request to said first device upon receipt of said instruction(see fig. 3, col. 1, lines 41-46 and col. 3, lines 20-64).

As per claim 38, Markus discloses an information transfer system according to claim 36, wherein said computer program means associated with said second device further causes said second device to forward said data items received from said first device to said third device (see fig. 3, col. 1, lines 41-46 and col. 3, lines 20-64), whereby said user may issue from said third device to said second device a confirmation signal that the data items are correct (see col. 3, lines 43-49, where the external entity 13, verifies and corrects the received content and sends the result selective proxy device).

As per claim 40, Markus discloses a web site hosted by a web server on a data network, said web site including a web page containing a request for data relating to a user of the web site, wherein said web page includes an option selectable by a user to cause the web server hosting the page to direct a request for data to a remote computer identifiable by said user. (i.e., fig. 2, content server 14 and 15 which inherently include web site for serving user requests, the servers contain data related user of the content server) (see col. 2, lines 20-37).

### **Conclusion**

Art Unit: 2157

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Salad E Abdullahi whose telephone number is 703-308-8441. The examiner can normally be reached on 8:30 - 5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Abdullahi Salad  
Examiner Au 2157  
6/12/2005